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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/975,492 | 10/11/2001 | Eugene Wolbers | 10906-007 | 9686 |

7590 10/04/2003

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| EXAMINER |
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WILLIAMS, ERIC M

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| ART UNIT | PAPER NUMBER |
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3681

DATE MAILED: 10/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,492

Applicant(s)

WOLBERS ET AL.

Examiner

Eric M Williams

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,16,17,39, and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the papers filed 08/25/2003 for serial number 09/975,492.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1 and 39 Applicant recites, "an *oil groove*...to retain a lubricant." Claims 16 and 42, which dependent from claims 1 and 39 respectively, recite, "an oil groove includes an *o-ring*." According to the Remarks submitted 02-25-2003 (page 5 and 6) and presented on page 17 paragraph [0058] lines 11-17 of the specification, "The present invention can be practiced without the presence of the o-ring 290, wherein the groove will act as a reservoir for retaining a lubricant." The oil groove, therefore, functions as a reservoir for retaining lubricant when an o-ring is *not* present, not when an o-ring is present as recited in claims 16, and 42.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonne ('371) in view of Smith ('569).

Lonne discloses a clutch release bearing (Fig. 2) with a bearing carrier Fig. 1 (1), a bearing assembly (2), a stationary race (5), a rotatable race (3), and a plurality of anti-friction elements (4), with an aligning ring (14), and the front face of the aligning ring defining a plane normal to the axis of the bearing carrier, and the rotatable race has a spherical face and the aligning ring has a spherical face engaging the spherical face of the rotatable race (Fig. 2).

Lonne lacks specific disclosure of an oil groove extending radially about the rotatable race to retain a lubricant. Smith ('569) discloses a groove (26) between two relatively rotatable spherical members (18 and 28) for retaining a lubricant. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lonne such that it has a groove between the two relatively rotatable members (the support ring and the aligning ring), in view of Thorson, to maintain a fluid tight seal for optimum lubricant effectiveness.

6. Claims 16 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonne ('371) in view of Becker ('324).

Lonne lacks the teaching of a groove with an o-ring. Becker discloses two spherical elements that are relatively rotatable (11, 10) with a groove and an o-ring (21) to retain lubricant. It would have been obvious to one of ordinary skill in the art at the time of this invention to modify Becker such that it had a groove with an o-ring, in view of Becker, to retain lubricant.

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lonne ('371) in view of Smith et al. ('569), further in view of Ernst et al. ('215).

Lonne in view of Smith lacks any specific teaching of a clearance fit between the bearing assembly and the bearing carrier. Ernst (Fig. 1) discloses a clearance fit between the bearing assembly and the bearing carrier (s) to allow for limited radial movement of the bearing assembly. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bearing assembly and bearing carrier of Lonne such that there is a clearance fit therebetween, in view of Ernst, to allow for limited radial movement of the bearing assembly.

8. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lonne ('371) in view of Smith ('569) in view of Ernst et al ('215) as applied to claim 39 above, and further in view of Lassiaz ('049).

Lonne in view of Smith and Ernst discloses all the limitations of claims 43 and 44 including a sleeve (column 2, lines 32-35), but lacks any specific teaching of snap rings or spring washers to hold the components in axial position. Lassiaz discloses a snap ring, spring washer (46) used to hold axial positioning. It would have been obvious to one of ordinary skill in the art at the time of this invention to modify Lonne in view of

Art Unit: 3681

Thorson and Ernst, such that a snap ring, spring washer is employed, in further view of Lassiaz, to hold the support sleeve and bearing assembly in axial position.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 16, 17, 39, 42, 43, and 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brenner ('735) and Chambers, Sr. ('713) both disclose o-ring seals in a groove. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M Williams whose telephone number is 703-305-0607. The examiner can normally be reached on Mon. - Fri. from 7:30am - 5:00pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A Marmor can be reached on 703-308-0830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



EMW



CHARLES A. MARMOR
SUPERVISORY PATENT EXAMINER
APT UNIT 3681